

ESTTA Tracking number: **ESTTA143368**

Filing date: **05/31/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91173189
Party	Plaintiff MONSTERCOMMERCE, LLC MONSTERCOMMERCE, LLC 10715 Norton Lane , IL 62286
Correspondence Address	Brian J. Winterfeldt Ballard Spahr Andrews & Ingersoll, LLP 601 13th Street, N.W. Washington, DC 20005-3807 UNITED STATES
Submission	Opposition/Response to Motion
Filer's Name	Hara K. Jacobs
Filer's e-mail	jacobsh@ballardspahr.com, winterfeldb@ballardspahr.com, larsont@ballardspahr.com, dcdocket@ballardspahr.com
Signature	/Hara K. Jacobs/
Date	05/31/2007
Attachments	Memorandum of Law.pdf (12 pages)(340584 bytes) Exhibits.pdf (15 pages)(294425 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 78/612,360
Published in the *Official Gazette* on May 30, 2006

TEMPLATEMONSTER

MONSTERCOMMERCE, LLC,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91173189
)	
IGOR LOGNIKO,)	
)	
Applicant.)	
)	

**MEMORANDUM OF LAW IN OPPOSITION
TO APPLICANT'S SECOND MOTION TO DISMISS**

Opposer, MonsterCommerce, LLC ("MonsterCommerce" or "Opposer"), submits this memorandum of law in opposition to Applicant, Igor Lognikov's¹ ("Applicant" or "Lognikov") second motion to dismiss.

PRELIMINARY STATEMENT

Applicant's second motion to dismiss is a transparent and groundless attempt to lash out at MonsterCommerce for discovering and bringing to the Board's attention Applicant's federal court admissions establishing that he is not the owner of the TEMPLATEMONSTER mark he seeks to register. Couching as a procedurally improper motion for relief from the Board's December 13, 2006 Order, Applicant alleges that MonsterCommerce lacks standing to maintain

¹ Applicant has filed a motion to amend the Application to reflect that the correct name of the applicant is Igor Lognikov and that the error in the Application is a spelling error. Accordingly, Opposer refers to Applicant herein as "Lognikov."

this opposition proceeding because it does not own the MONSTERCOMMERCE mark or other marks in its MONSTER family of marks. The claimed basis for Applicant's contention is an opposition proceeding filed on a different continent, where entirely different trademark rights, laws and rules of practice exist. There is no conceivable ground for Applicant's motion under Trademark Trial and Appeal Board jurisprudence or the extant order in this proceeding. MonsterCommerce has standing to maintain this Opposition because, as the Board previously held, MonsterCommerce alleges that it has used and currently uses a family of MONSTER marks, including the MONSTERCOMMERCE mark, for a broad range of online services, including software for building websites, and believes it will be damaged by Applicant's registration of the TEMPLATEMONSTER mark for software for developing websites. (Board Order dated December 13, 2006 ("December 13th Order"), Exh. A.) Applicant's motion, which does not address this critical portion Board's December 13th Order, and ignores the most basic principles of standing, is deserving of sanctions.

FACTUAL BACKGROUND

Applicant seeks to register the mark TEMPLATEMONSTER for software for developing websites using pre-formatted templates and for website design services. MonsterCommerce is the owner of a federal registration for the mark MONSTERCOMMERCE for, inter alia, software enabling users to build an e-commerce website. MonsterCommerce uses the MONSTERCOMMERCE mark and a family of MONSTER marks for its e-commerce services, including e-commerce design software and systems, website design, promotion and hosting, merchant accounts, and domain name services. MonsterCommerce instituted this Opposition on the ground that the mark TEMPLATEMONSTER is likely to cause confusion with the MONSTERCOMMERCE mark and its family of MONSTER marks.

PROCEDURAL HISTORY

MonsterCommerce instituted this Opposition in September 2006. Applicant filed its first motion to dismiss in October 2006. As grounds for the motion, Applicant alleged that the Board lacked subject matter jurisdiction over the proceeding because Network Solutions, LLC (“Network Solutions”), not MonsterCommerce, had filed the Request for an Extension of Time to File the Opposition. Additionally, Applicant argued that MonsterCommerce lacked standing to maintain the proceeding because its pleaded federal registration for the MONSTERCOMMERCE mark was in the name of MonsterCommerce, Inc. not MonsterCommerce, LLC.

MonsterCommerce opposed Applicant’s motion to dismiss and filed an Amended Notice of Opposition with its responsive brief. MonsterCommerce explained that it is a wholly owned subsidiary of Network Solutions and, as such, is in privity with Network Solutions. Because Network Solutions is in privity with MonsterCommerce, the Opposition was timely filed and the Board has subject matter jurisdiction over the Opposition. MonsterCommerce further explained that the federal registration for the MONSTERCOMMERCE mark issued in the name of MonsterCommerce, Inc. instead of MonsterCommerce LLC, is a correctable clerical error and does not affect MonsterCommerce’s standing.

In an Order dated December 13, 2006, the Board held that it had subject matter jurisdiction over the proceeding and that MonsterCommerce had standing to maintain the Opposition. (December 13th Order at pp. 6, 9, Exh. A.) The Board agreed that because MonsterCommerce provided uncontradicted evidence that, prior to the filing of the Notice of Opposition, it was a wholly owned subsidiary of Network Solutions and that Network Solutions controlled MonsterCommerce’s assets, MonsterCommerce was in privity with Network Solutions, thus the Notice of Opposition was timely filed. (*Id.* at p. 5.) On the issue of standing,

the Board provided a full legal analysis, enunciating the statutory and judicially created requirements, and their applicability to this proceeding. (Id. at pp. 7-8.) The Board held that MonsterCommerce had standing, not because it alleged ownership of a federal trademark registration, but because it alleged prior use of a family of MONSTER marks in connection with a broad range of online services, which “demonstrate[ed] a real interest in the outcome of the proceeding and a reasonable basis for a belief of damage.” (Id. at pp. 8-9.) In reaching its holding, the Board expressly stated that it assumed, for the sake of argument, that MonsterCommerce did not own the pleaded registration. (Id. at p. 8.)

On January 31, 2007, MonsterCommerce filed a motion for partial judgment on the pleadings seeking dismissal of the affirmative defenses of laches, equitable estoppel and legal estoppel because there is no legal basis to assert these defenses in this Opposition proceeding. On February 12, 2007, Applicant filed a motion to compel discovery, despite failing to satisfy his obligation to meet and confer in good faith and despite failing to file the requisite certificate of good faith. On February 20, 2007, MonsterCommerce filed a second motion to amend the opposition on the ground that Applicant is not the owner of the TEMPLATEMONSTER mark based on express admissions made by him to a federal court in Florida, which MonsterCommerce had recently uncovered. On March 5, 2007, the Board suspending the proceedings pending the outcome of the three pending motions and instructed the parties not to file any papers that were not germane to the three motions.

On May 8, 2007, in derogation of the Board’s March 5th Order, Applicant filed the instant motion “for relief from order based on fraud.” Shortly thereafter, on May 11, 2007, the Interlocutory Attorney issued an Order in response to Applicant’s motion. (Order dated May 11, 2007, Exh. B.) The Order stated that to the extent Applicant sought relief from the December

13th Order, the motion was untimely. (Id. at p. 1.) The Order further explained that because the motion presented new arguments and evidence in support of Applicant's contention that the Opposition should be dismissed, the motion for relief was actually a renewed motion to dismiss and that the Board would treat it accordingly. (Id. at p. 1.) Finally, the Order directed MonsterCommerce to file its response within twenty days, and again directed the parties not to file any further motions until the pending motions are decided. (Id.)

ARGUMENT

Applicant's motion to dismiss is baseless. It fundamentally ignores not only the most basic legal principles governing TTAB practice but the holding and reasoning of the Board's December 13th Order. Opposer, MonsterCommerce, has standing to maintain this Opposition proceeding because it alleges prior use of the MONSTERCOMMERCE mark and a family of MONSTER marks to designate the source of online services, including its software for building websites, and it believes it will be damaged by Applicant's registration of the mark TEMPLATEMONSTER for software for developing websites. That central allegation, which Applicant does not and has never disputed, is the end of the standing inquiry because it indisputably establishes that MonsterCommerce has a real interest in the case.

Applicant's contention, that MonsterCommerce lacks standing because its parent, Network Solutions, is the claimed owner of the MONSTERCOMMERCE mark and the family of MONSTER marks in Europe, is fallacious. MonsterCommerce has standing whether or not it is the "owner" of the family of MONSTER marks in any country because it indisputably uses the marks in commerce, which is more than sufficient to confer standing in an opposition proceeding based on likelihood of confusion. Moreover, ownership of a mark outside of the United States is manifestly irrelevant to these proceedings because trademark rights are territorial. Applicant

cannot attack MonsterCommerce's ownership rights in the United States based on opposition pleadings filed in Europe.

I. MONSTERCOMMERCE HAS STANDING BECAUSE IT ALLEGES PRIOR USE OF A FAMILY OF MONSTER MARKS AND DAMAGE

Applicant's motion to dismiss alleges that the Board lacks subject matter jurisdiction over this proceeding because MonsterCommerce does not have standing to assert the Opposition. (May 11th Order, Exh. B) (interpreting Applicant's motion). Standing is governed by Section 13(a) of the Lanham Act, which provides that:

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefore

15 U.S.C. § 1063(a). By its terms, the statute establishes a broad class of persons who are proper opposers --persons who have a belief that they would suffer some kind of damage if the mark is registered. Ritchie v. Orenthal James Simpson, 170 F.3d 1092, 50 U.S.P.Q.2d 1023, 1025 (Fed Cir. 1999). The purpose of the standing requirement is to prevent litigation between parties where there is no real controversy, where a plaintiff is no more than an intermeddler. Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 1029, 213 U.S.P.Q. 185, 189 (CCPA 1982). MonsterCommerce, which has alleged that it will be damaged if Applicant is permitted to register the mark TEMPLATEMONSTER for software for designing websites because it uses a family of MONSTER marks for a variety of online services, including software for developing websites, amply satisfies the statutory standing requirement. J.L. Prescott Co. v. Blue Cross Laboratories (Inc.), 216 U.S.P.Q. 1127, 1128 (TTAB 1982) (finding that opposer had standing by virtue of its use of the mark pursuant to a license). Likewise, MonsterCommerce satisfies the purpose of the standing requirement because it has a direct business pecuniary interest in the matter. See Lipton, 670 F.2d at 1028-28, 213 U.S.P.Q. at 189. It is not a mere intermeddler. Id.

In addition to meeting the broad requirements of Section 13(a), an opposer is required to demonstrate two judicially-created requirements -- a real interest in the proceeding and a reasonable basis for belief of damage. Ritchie, 170 F.3d at 1095, 50 U.S.P.Q.2d at 1027; Universal Oil Prod. Co. v. Rexall Drug & Chem. Co., 463 F.2d 1122, 174 U.S.P.Q. 458, 459 (CCPA 1972); TBMP ¶ 309.03(b). A party has a “real interest” if it has a direct and personal stake in the outcome of the opposition. Ritchie, 170 F.2d at 1095, 50 U.S.P.Q.2d at 1026; TBMP ¶ 309.03(b). A party has a reasonable basis for belief of damage if the belief has a reasonable basis in fact. Ritchie, 170 F.2d at 1095, 50 U.S.P.Q.2d at 1027; TBMP ¶ 309.03(b). Where the “plaintiff pleads (and later proves) a likelihood of confusion that is not wholly without merit,” plaintiff establishes a real interest in the proceeding and a reasonable basis for belief as a matter of law. TBMP ¶ 309.03(b); see Lipton, 670 F.2d at 1029, 213 U.S.P.Q. at 189.

MonsterCommerce indisputably meets the test for standing because its Notice of Opposition pleads a compelling case of likelihood of confusion between marks that incorporate the same distinctive term “MONSTER” and that designate the source of virtually the same services. See Lipton, 670 F.2d at 1029, 213 U.S.P.Q. at 189; TBMP ¶ 309.03(b).

Applicant contends, with no legal authority, that MonsterCommerce’s parent, Network Solutions, is the only party who could have filed this Opposition because Network Solutions is allegedly the owner of the family of MONSTER marks. (Motion to Dismiss at ¶ 4.) This contention is not only wrong, it is directly contradicted by the Board’s December 13th Order and literally decades of precedence on the issue of standing. In response to Applicant’s first motion to dismiss, the Board rejected the notion that MonsterCommerce would lack standing if it did not “own” the MONSTER mark. The Board held:

Even if we were to assume for sake of argument that opposer is not the owner of the pleaded registration, we find that opposer has met

the requirement of having alleged that its interests will be damaged from the issuance of the registration to applicant. Opposer has alleged prior use of a family of marks including the term MONSTER These allegations demonstrate a real interest in the outcome of the proceeding and a real basis for a belief of damage.

(December 13th Order, Exh. A.) Applicant's new motion to dismiss does not address this holding or any facts relating to this holding. Indeed, it says nothing at all about MonsterCommerce's use of the family of MONSTER marks in the United States. Instead, the motion propounds the baseless argument that because Network Solutions filed an opposition to Applicant's attempt to register the mark TEMPLATEMONSTER in Europe, MonsterCommerce cannot own the family of MONSTER marks in the United States. The Board's prior Order is dispositive of Applicant's motion to dismiss and, as such, mandates denial of the motion. See AM General Corp. v. DaimlerChrysler Corp., 246 F. Supp. 2d 1030, 1033 (N.D. Ind. 2003) ("Under the law of the case doctrine . . . 'when a court decides upon a rule of law, that decision should continue to govern the same issue in subsequent stages of the same case.'") (quoting United States v. Story, 137 F.3d 518, 520 (7th Cir. 1998)).

In addition to the Board's December 13th Order, decades of legal precedence likewise belie Applicant's argument that only the "owner" of a mark has standing to file an opposition. As stated over thirty years ago by the Court of Customs and Patent Appeals, "Control over the mark or name relied upon is not determinative of standing to oppose. Standing . . . is found when the opposer establishes a real interest in the proceeding." Universal Oil, 463 F.2d 1122, 174 U.S.P.Q. at 458. A real interest can be something as common and direct as prior use of a mark or something more atypical and attenuated. See Lipton, 670 F.2d at 1029, 213 U.S.P.Q. at 189. For example, an opposer who had assigned its ownership rights in a mark to a third party and obtained a license in return had standing based on its alleged prior use of the mark. J.L.

Prescott Co., 216 U.S.P.Q. at 1128. A trade association that relied on its members for income had standing to oppose a mark even though the association itself did not deal in the goods because registration of the mark would weaken the sales position of its members, and thereby weaken the income of the trade association. Tanners' Council of America, Inc. v. Gary Industries Inc., 440 F.2d 1404, 1406-07, 58 CCPA 1201, 1203-04 (CCPA 1971). As is clear from these examples, MonsterCommerce's ownership of the MONSTER marks is irrelevant to the issue of standing. MonsterCommerce has standing because it has a real interest in the proceeding by virtue of its allegation that Applicant is attempting to register a mark that is confusingly similar to marks that MonsterCommerce has been using long prior to Applicant.

II. APPLICANT'S CONTENTION THAT NETWORK SOLUTIONS IS THE OWNER OF A FAMILY OF MONSTER MARKS IN EUROPE IS IRRELEVANT

Applicant argues that it is entitled to relief from the Board's December 13th Order because opposition pleadings in Europe purportedly indicate that MonsterCommerce and Network Solutions fraudulently misrepresented ownership of the family of MONSTER marks in the United States, and that these alleged misrepresentations resulted in the Board's decision holding that MonsterCommerce has standing to maintain this Opposition. Applicant's baseless and far fetched allegation of fraud is a cheeky and meritless response to MonsterCommerce's recent discovery of Applicant's admissions that it is not the owner of the TEMPLATEMONSTER mark and MonsterCommerce's concomitant motion to amend its Notice of Opposition to add fraud as a basis for the Opposition.

As explained, infra, the Board's December 13th Order holding that MonsterCommerce has standing to maintain the Opposition is not based on an allegation that MonsterCommerce is the owner of a family of MONSTER marks. It is based on the allegation that MonsterCommerce uses a family of MONSTER marks in commerce to designate the source of its online services --

an allegation that Applicant does not refute. Thus, the purported fraud that Applicant has alleged is irrelevant to the Board's December 13th Order and, as such, cannot form the basis of a request for relief from that Order.

Moreover, Applicant's so-called evidence of fraud, a pleading filed in an opposition proceeding in Europe, is simply immaterial to ownership of the MONSTER marks in the United States. "The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according that country's statutory scheme." Person's Co., Ltd. v. Christman, 900 F.2d 1565, 1568-69, 14 U.S.P.Q.2d 1477, 1479 (Fed. Cir. 1990). It is for this reason that evidence of a party's foreign activities, including foreign trademark ownership and use, is not relevant to issues in an opposition proceeding. Double J of Broward Inc. v. Skalony Sportwear GmbH, 21 U.S.P.Q.2d 1609, 1612 (TTAB 1992). Here, Applicant relies solely on an opposition pleading filed in Europe containing statements about trademark ownership in Europe, to claim that MonsterCommerce is not the owner of the family of MONSTER marks in the United States and to claim that MonsterCommerce and its parent, Network Solutions, have committed fraud before the Board. (Motion to Dismiss at ¶ 2.) Because the "evidence" that Applicant relies upon -- evidence of foreign trademark ownership -- is not relevant to this Opposition proceeding, Applicant has no basis for his contentions and his motion fails as a matter of law.

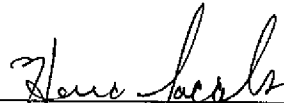
CONCLUSION

For all the foregoing reasons, MonsterCommerce respectfully requests that the Board deny Applicant's second motion to dismiss.

Respectfully submitted,

Date: May 31, 2007

By: _____



Hara K. Jacobs

Brian J. Winterfeldt

BALLARD SPAHR ANDREWS & INGERSOLL, LLP

601 13th Street, NW, Suite 1000 South

Washington, D.C. 20005

(202) 661-2200

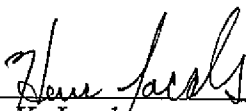
ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I, Hara K. Jacobs, hereby certify that on today's date, I caused a copy of the foregoing Opposer's Memorandum of Law in Opposition to Applicant's Motion to Dismiss to be served by United States First Class mail, postage prepaid, on counsel for Applicant as set forth below:

Richard S. Ross, Esq.
Attorney for Applicant
4801 South University Drive
Suite 237
Ft. Lauderdale, Florida 33328
Tel (954) 252-9110
Fax (954) 252-9192
E mail prodp@ix.netcom.com

Dated: May 31, 2007



Hara K. Jacobs

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: December 13, 2006

Opposition No. 91173189

MonsterCommerce, LLC

v.

Igor Logniko

Before Bucher, Rogers and Drost,
Administrative Trademark Judges

By the Board:

Igor Logniko ("applicant") filed an application to register the mark TEMPLATEMONSTER in standard character form for "online retail services featuring downloadable software for website development comprising pre-formatted modifiable templates" in International Class 35 and "website development services, namely, providing website design services for others" in International Class 42.¹

After *ex parte* examination, the application was published for opposition on May 30, 2006. On June 16, 2006, Network Solutions, LLC ("Network") filed a request for a ninety-day extension of time to oppose, which the Board

¹ Application Serial No. 78612360, filed April 19, 2005, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), and alleging April 12, 2002 as the date of first use and April 15, 2002 as the date of first use in commerce.

Opposition No. 91173189

granted on that day. Based thereon, Network was allowed until September 27, 2006 to file a notice of opposition.

On September 27, 2006, MonsterCommerce, LLC ("opposer") filed a notice of opposition alleging likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) with its "family" of marks which include the term MONSTER.² Opposer's pleaded marks include the mark MONSTERCOMMERCE for "computer services, namely, providing on-line non-downloadable software that enables users to sell their products or services on-line, namely, software facilitating the practicing of e-commerce services and e-commerce shopping portal services," which is the subject of Registration No. 2947368. The Board instituted this proceeding on October 2, 2006.

In lieu of an answer, applicant, on October 17, 2006, filed a motion to dismiss under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction and under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief

² Opposer also alleged that registration of applicant's mark would be likely to cause dilution of opposer's family of marks including the term MONSTER. However, opposer did not allege that its pleaded marks became famous prior to applicant's application filing date and/or applicant's first use of his involved mark. See *Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). Accordingly, opposer did not properly plead a dilution claim in this proceeding. Based on the foregoing, we will treat the notice of opposition as setting forth a Section 2(d) claim only.

Because the notice of opposition was filed in the name of a party other than the party which was granted an extension of time to oppose, the Board should have required opposer to show that it is in privity with Network. See TBMP Section 206.02 (2d ed. rev. 2004).

Opposition No. 91173189

can be granted.³ Opposer incorporated a motion for leave to file an amended pleading into its brief in response thereto and concurrently filed an amended notice of opposition. Applicant filed both a reply brief in support of the motion to dismiss and a brief in response to the motion for leave to file an amended notice of opposition.

In support of his motion to dismiss, applicant contends that, because opposer did not file its notice of opposition within thirty days after applicant's application was published for opposition and did not request an extension of time to oppose registration of applicant's mark, the notice of opposition is untimely, and that the Board lacks subject matter jurisdiction. In addition, applicant contends that, because USPTO records indicate that the pleaded registration is owned by MonsterCommerce, Inc., a California corporation, and not by opposer, opposer lacks standing to maintain this proceeding. Applicant's exhibits in support of its motion include: 1) a copy of the pleaded registration from the USPTO's Trademark Electronic Search System (TESS); 2) an Office Action issued by the USPTO's Post-Registration Branch, in which opposer's request to correct the name of

³ Such motion was filed by "Igor Lognikov" and appears intended to correct a spelling error in applicant's name in his application. However, unless applicant files a motion to amend his involved application and that motion is granted, the caption of this proceeding will remain as set forth hereinabove. See Trademark Rule 2.133(a); TBMP Section 514 (2d ed. rev. 2004); and TMEP Sections 803.06 and 1201.02(c) (4th ed. 2005).

Opposition No. 91173189

the registrant in the the pleaded registration was not accepted; and 3) a response to that Office Action. Based on the foregoing, applicant asks that the opposition be dismissed.

In response and in support of its motion for leave to file an amended pleading, opposer contends that the opposition was timely filed because opposer is in privity with Network by virtue of its being a wholly-owned subsidiary thereof; that opposer owns the pleaded registration, but misidentified itself in that registration; that opposer has filed with the USPTO's Post-Registration Branch a request to correct the misidentification of itself in that registration; and that there is no such California corporation as MonsterCommerce, Inc. Opposer's exhibits in support of its position include: 1) a declaration of Network's senior vice-president and general counsel, wherein the declarant attests that Network acquired opposer on January 4, 2005 and controls opposer's assets; 2) a copy of a response to an Office Action issued by the USPTO's Post-Registration Branch, in support of opposer's request to correct the pleaded registration, which includes a declaration from opposer's general counsel; and 3) reprints of online records of the California Secretary of State which show no entries for a corporation named MonsterCommerce, Inc. Based on the foregoing, opposer asks that the Board

Opposition No. 91173189

deny applicant's motion to dismiss and accept its concurrently filed amended notice of opposition.

In a reply brief in support of the motion to dismiss, applicant contends that opposer cannot be in privity with Network because it has not alleged that Network ever owned the pleaded registration; and that opposer's showing of privity is untimely.

In response to opposer's motion for leave to amend, applicant contends that opposer's proposed amended pleading is futile because it does not alter references in the original pleading regarding ownership and use of pleaded registration.

We turn first to applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction over the involved application. An opposition must be filed within thirty days after publication of the application being opposed or within an extension of time for filing an opposition. See Trademark Rule 2.101(c). An extension of time to oppose is a personal privilege, inuring only to the benefit of the party to which it was granted or a party shown to be in privity therewith. See *Cass Logistics, Inc. v. McKesson Corp.*, 27 USPQ2d 1075 (TTAB 1993). A wholly-owned subsidiary is in privity with its parent company. See *F. Jacobson & Sons, Inc. v. Excelled*

Opposition No. 91173189

Sheepskin & Leather Coat Co., 140 USPQ 281, 282 (Comm'r 1963); TBMP Section 206.02 (2d ed. rev. 2004).

Inasmuch as opposer has provided uncontradicted evidence that it is, and has been since prior to the filing of the notice of opposition, a wholly-owned subsidiary of Network and that Network controls opposer's assets, we find that opposer is in privity with Network.⁴ Cf. TMEP Section 1201.07 (4th ed. 2005). Because the notice of opposition was filed by a party in privity with Network on the last day of Network's extension of time to oppose, the notice of opposition was timely filed.⁵ The motion to dismiss under Fed. R. Civ. P. 12(b)(1) for lack of subject matter jurisdiction is therefore denied.

We turn next to applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted. Inasmuch as no answer is of record, opposer may amend its pleading once as a matter of course. See Fed. R. Civ. P. 15(a); TBMP Section 507.02 (2d

⁴ However, the better practice would have been for Network to name every potential opposer in its request to extend time to oppose. See TBMP Section 206.02 (2d ed. rev. 2004).

⁵ We are not persuaded by applicant's contention that opposer's showing of privity is somehow untimely. Although opposer did not submit a showing of privity with the notice of opposition, the Board did not require opposer to explain why the notice of opposition was filed in the name of a party other than Network. It would be unfair to penalize opposer for not complying with a requirement that the Board did not issue. Cf. *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989).

Opposition No. 91173189

ed. rev. 2004). Accordingly, opposer's amended notice of opposition is accepted as the operative complaint herein, and both opposer's motion for leave to file an amended pleading and applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) are moot.

Applicant contends, in his brief in response to opposer's motion for leave to file an amended notice of opposition, that the amended notice of opposition also fails to state a claim upon which relief can be granted. Accordingly, we will treat the brief in response as a renewed motion to dismiss under Fed. R. Civ. P. 12(b)(6). Although opposer has not responded thereto, we elect to decide the renewed motion to dismiss on the merits at this time. See Trademark Rule 2.127(a).

To withstand a motion to dismiss under Rule 12(b)(6), a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denial the registration sought. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

With regard to opposer's standing to maintain this proceeding, the starting point for a standing determination in an opposition proceeding is Trademark Act Section 13(a),

Opposition No. 91173189

15 U.S.C. Section 1063(a), which provides that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor"

Trademark Act Section 13 establishes a broad class of persons who are proper opposers; by its terms the statute only requires that a person have a belief that he would suffer some kind of damage if the mark is registered. However, in addition to meeting the broad requirements of Section 13, an opposer must have both a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damage. See, e.g., *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 174 USPQ 458, 459 (CCPA 1972).

Even if we were to assume for sake of argument that opposer is not the owner of the pleaded registration,⁶ we find that opposer has met the requirement of having alleged that its interests will be damaged from the issuance of the registration to applicant. Opposer has alleged prior use of

⁶ Opposer has provided evidence from the online records of the Secretary of State of California that there is no such California corporation as MonsterCommerce, Inc. Thus, it appears that opposer merely misidentified itself in the underlying application for the pleaded registration, and that such misidentification is a correctable error. See Trademark Act Section 7(h), 15 U.S.C. Section 1057(h); TBMP Section 512.04 (2d ed. rev. 2004); and TMEP Sections 1201.02(c) and 1609.10(b) (4th ed. 2005).

Opposition No. 91173189

a family of marks including the term MONSTER in connection with

a broad range of online services... [which] include ... providing on-line shopping cart software which is used for the purpose of designing, hosting, implementing, and maintaining websites and specifically providing built-in and customizable website templates and graphics, website optimization tools and plug-ins, web-based administration for on-line stores, email accounts, credit card processing, an order management system, and technical support services.

These allegations demonstrate a real interest in the outcome of the proceeding and a reasonable basis for a belief of damage. Accordingly, we find that opposer has adequately pleaded its standing to maintain this proceeding.

We turn next to whether opposer has set forth a valid ground for denying applicant the registration he seeks. To properly state a claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), opposer must plead that 1) applicant's mark, as applied to his goods or services, so resembles opposer's trademark(s) as to be likely to cause confusion, mistake, or deception; and 2) that opposer is the prior user of its pleaded mark(s). See Fed. R. Civ. P. 8; *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Opposer has so pleaded in paragraphs 2 through 7 of the notice of opposition.

In view thereof, applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim is denied with regard to opposer's Section 2(d) claim.

Opposition No. 91173189

Opposer also alleged in paragraph 8 of the amended notice of opposition that registration of applicant's mark is likely to cause dilution of opposer's family of marks including the term MONSTER. However, opposer did not allege that its pleaded marks became famous prior to the applicant's application filing date and/or applicant's first use of his involved mark. See *Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001). Accordingly, opposer did not properly plead a dilution claim.

In view thereof, applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim is granted with regard to opposer's dilution claim. Opposer's dilution claim is hereby dismissed and will receive no further consideration.

Proceedings herein are resumed. Applicant is allowed until thirty days from the mailing date set forth in the caption of this order to file an answer to the amended notice of opposition. Discovery and testimony periods are hereby reset as follows.

DISCOVERY PERIOD TO CLOSE: **6/15/07**

Plaintiff's 30-day testimony period to close: **9/13/07**

Defendant's 30-day testimony period to close: **11/12/07**

Plaintiff's 15-day rebuttal testimony period to close: **12/27/07**

Opposition No. 91173189

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: May 11, 2007

Opposition No. 91173189

Monstercommerce, LLC

v.

Igor Logniko

Andrew P. Baxley, Interlocutory Attorney:

On March 5, 2007, the Board issued an order wherein it suspended this case pending disposition of applicant's motion to amend involved application Serial No. 78612360, opposer's motion for partial judgment on the pleadings, opposer's motion to compel discovery, and opposer's motion for leave to file a second amended notice of opposition. In that order, the Board indicated that the parties should not file any submission which is not germane to those motions.

On May 8, 2007, applicant filed a motion for relief from the Board's December 13, 2006 order. To the extent that applicant requests relief from the December 13, 2006 order, the motion is untimely because any request for reconsideration of that order was due by not later than January 16, 2007. See Trademark Rules 2.127(b) and 2.196. Further, because the motion for relief presents new arguments and evidence in support of applicant's contention

Opposition No. 91173189

that this proceeding should be dismissed, the motion for relief is actually a renewed motion to dismiss under Fed. R. Civ. P. 12(b)(1). See TBMP Section 518 (2d ed. rev. 2004). The Board will treat the renewed motion to dismiss accordingly.

A review of the renewed motion to dismiss indicates that it involves different issues from those in the motions which prompted the March 5, 2007 suspension order. As such, it is not germane to those motions and was thus filed in contravention of the suspension order. Nonetheless, inasmuch as the renewed motion to dismiss is potentially dispositive of this proceeding and could render moot all of the remaining pending motions herein, the Board finds that, in the interest of judicial economy, the renewed motion to dismiss should be fully briefed prior to the Board's decision on the remaining pending motions. Accordingly, opposer is allowed until twenty days from the mailing date of this order to file a brief in response to the renewed motion to dismiss. Applicant's reply brief is due in accordance with Trademark Rules 2.119(c) and 2.127(a).

The parties are directed, however, not to file any further motions until the motions currently pending before the Board in this proceeding have been decided. See TBMP Section 527.03 (2d ed. rev. 2004).